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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,470

Applicant(s)

SUGIMOTO ET AL.

Examiner

JACOB C. COPPOLA

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This action is in reply to the Amendments and Remarks filed on 28 October 2008.
2. Claims 15-21 are currently pending and have been examined.
3. This Office Action is given Paper No. 20090202. This Paper No. is for reference purposes only.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 15-21 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
6. Regarding claims 15-21:
 - a. These claims recite computer programs only. “Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed.” MPEP §2106.01 I. Because the claims recite only abstractions that are neither “things” nor “acts”, the claims are not within one of the four

statutory classes of invention¹. Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

b. Additionally, the Examiner notes that using the broadest reasonable interpretation of “unit” and “recording medium”, as noted below, the claimed units and recording medium are interpreted as software only. Because the broadest reasonable interpretation of “unit” and “recording medium” includes software only, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

7. Regarding claim 16:

c. This claim is directed to neither a “process” or a “machine” but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

Accordingly, claim 16 and its dependents are rejected under §101.

Claim Rejections - 35 USC § 112, 2nd Paragraph

8. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 15-21 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

¹ 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures, and composition of matter. The latter three categories define “thing” (or products) while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed).

10. Regarding claim 15:

d. This claim is indefinite because it is unclear to one of ordinary skill in the art whether Applicants are claiming the subcombination of a “playback apparatus” or the combination of a “playback apparatus” and an “optical disc.”

e. If it is Applicants’ intent to claim only the subcombination, the body of the claims must be amended to remove any positive recitation of the combination. If it is Applicants’ intent to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim. For the latter, the Examiner recommends claiming “a system.” This applies to any dependent claims as well.

11. Regarding claim 15:

f. This claim recites “a playback unit that plays the content *when the judging unit judges that the disc region code matches the apparatus region code*” [emphasis added]. This claim is indefinite because one of ordinary skill in this art would not understand the scope of the claim if *the judging unit judges that the disc region code does not match the apparatus region code*.

g. Moreover, this claim recites “the play back unit plays back a predetermined package... *when the judging unit judges that the disc region code does not match the apparatus region code and when a combination of the content identifier read by the reading unit and the apparatus region code satisfies a predetermined condition*” [emphasis added]. This claim is indefinite because one of ordinary skill in this art would not understand the scope of the claim if *the judging unit judges that the disc region code does match the apparatus region code and a combination of the content identifier read by*

the reading unit and the apparatus region code does not satisfy a predetermined condition.

12. Regarding claims 15 and 16:

h. This claim is indefinite because it is considered a hybrid claim. See MPEP §2173.05(p) II. In particular, the claim is directed to neither a “process” or a “machine” but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

i. For example, claim 15 recites “A playback apparatus.” Additionally, dependent claims 16-21 also state “The playback apparatus of claim 1[x]” respectively. In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicants to claim a machine claim. Alternatively, claim 15 recites “a predetermined package created by *replacing* the predetermined part of the content... with the substitute content” [emphasis added]. One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicants to claim a process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claim 15 to be drawn to either a product or process.

j. Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicants would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite. If Applicants overcome this particular 35

U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn.

k. The same issues noted above in claim 15 apply equally to claim 16.

13. Regarding claims 18 and 19:

l. This claim is indefinite because it is unclear to one of ordinary skill in the art whether Applicants are claiming the subcombination of a "playback apparatus" or the combination of a "playback apparatus" and a "server apparatus."

m. Claims 15 begins by stating "A playback apparatus" Dependent claims 16-21 also begin by stating "The playback apparatus of claim 1[x]" respectively. The body of claim 15 recites various structural elements such as "a judging unit," a reading unit," and a playback unit" which, according to the drawings and specification, are all within the playback apparatus. In light of this, one of ordinary skill in the art could reasonably interpret the recitations above as evidence of an express intent by Applicants to claim *only* a playback apparatus.

n. However claim 18 also recites in the body of the claim, that the authorization request is sent "to a sever apparatus" Additionally, claim 19 states "the server apparatus includes" various structural elements. These discussions of a "server apparatus" as noted above are evidence that Applicants intend to claim a "server apparatus" *in addition* to the playback apparatus. In light of this evidence, one of ordinary skill in the art could reasonably conclude that Applicants intend claims 18 and 19 to include a "server apparatus" as well.

- o. In light of this conflicting evidence, a person of ordinary skill in the art could *not* reasonably determine if Applicants intend to claim just the the subcombination of a “playback apparatus” or alternatively, the combination of a “playback apparatus” *and* a “server apparatus.” In other words, the scope of the claims is indefinite.
 - p. If it is Applicants’ intent to claim only the subcombination, the body of the claims must be amended to remove any positive recitation of the combination. If it is Applicants’ intent to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim. For the latter, the Examiner recommends claiming “a system.” This applies to any dependent claims as well.
- 14. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

- 15. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada et al. (U.S. 6,141,483 A) (“Yamada”), in view of Yoshii et al. (U.S. 2003/0090711 A1, now U.S. Patent No. 7,239,417 B2) (“Yoshii”), and in further view of Candlore et al. (U.S. 2003/0174837 A1) (“Candlore”).

17. Regarding claim 15:

q. Yamada discloses *a playback apparatus for playing back an optical disc* (see column 3, lines 40-49: “reproducing apparatus”). Yamada, further, discloses *a judging unit that judges whether a disc region code (“medium region code”) assigned to an optical disc matches an apparatus region code assigned to the playback apparatus* (see at least column 3, lines 57-61), *and a reading unit that reads a content identifier of content recorded on the optical disc* (see at least column 10, lines 16-17: “recorded data is read from the recording medium by an optical pickup”), *and a playback unit that plays back the content when the judging unit judges that the disc region code matches the apparatus region code* (see figure 6 and associated text; and column 9, lines 36-39).

a. Yamada does not specifically disclose *a recording medium that stores predetermined additional data corresponding to the optical disc, and the recording medium being distinct from the optical disc*.

b. Yoshii, however, does disclose *a recording medium* (“second distribution means”) *that stores predetermined additional data (“secondary data”) corresponding to a first recording medium* (see ¶0010 and ¶0011), *and the recording medium being distinct from a first recording medium* (see ¶0010 and ¶0011).

c. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the first recording medium of Yoshii for the optical disc of Yamada. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.

d. Additionally, Yamada/Yoshii does not specifically disclose *the predetermined additional data including a substitute playback order of the content recorded on the optical disc and a substitute content, the substitute content replacing a predetermined part of the content recorded on the optical disc.*

e. Candelore, however, does disclose *predetermined additional data including a substitute playback order of the content recorded on an optical disc and including substitute content, the substitute content replacing a predetermined part of the content recorded on the optical disc* (see the abstract, figure 5, and associated text).

f. One of ordinary skill in the art would have recognized that applying the known technique of Candelore would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Candelore to the teachings of Yamada/Yoshii would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such substitute playback features into similar systems. Further, applying the substitute playback order and substitute content that replace the originals to Yamada/Yoshii with predetermined additional data in relation to an optical disc, would

have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow for a higher level of consumer satisfaction.

2. Claims 16-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamada/Yoshii/Candelore, in further view of Applicants' Own Admission ("AOA").

3. Regarding claim 16:

g. Yamada/Yoshii/Candelore discloses the limitations of claim 15, as described above. Yamada/Yoshii/Candelore, further, disclose *the content includes playlist information, the playlist information is information including one or more pairs of start time information and end time information in a playback time axis of the AV stream, each pair of start time information and end time information defining a playback section* (see Yoshii, ¶0011: "a reproduction start point and a reproduction end point correspond to an image frame-specific code for specifying an image frame of the digital image data"), and *the content includes a dynamic scenario, the dynamic scenario is a program that causes the playback apparatus to play back the playlist information* (see Yoshii, ¶0011: "such that the second reproduction means leads out the reproduction start point and the reproduction end point corresponding to the image frame to be reproduced during the reproduction of the digital image data"), and *the predetermined additional data* (see Yoshii, ¶0016: "secondary data") *is any of the AV stream* (see Yoshii, ¶0015: "subtitles"), *the playlist information, and the dynamic scenario supplied to the playback apparatus via a network* (see ¶0016: "the server and the user terminal being connected [to] each other through [the] Internet"), and *the playback of the created predetermined package includes (i) a playback of one of an additional audio stream and an additional subtitle stream that*

are not recorded on the optical disc (see Yoshii, ¶0015: “as the secondary data, multimedia such as character, sound, and image can be treated”), and (ii) *a playback of a playback section of the AV stream that is different from the playback section defined by the playlist information of the optical disc* (see figures 3 and 4 – showing the “created predetermined package” containing different data collectively than that of “digital image data 11” (i.e., optical disc)). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to design a content rendering apparatus, as disclosed by Yamada, to include the ability to render the same data-structure as the rendering apparatus disclosed by Yoshii. One would have been motivated to do so because this would generate higher revenue sales of the apparatus for providing, by design, additional venues for the apparatus to be utilized in.

h. Yamada/Yoshii/Candelore does not explicitly disclose *the content includes an AV stream, the AV stream is a stream obtained by multiplexing a video stream, an audio stream, and a subtitle stream.*

i. AOA, however, discloses that content in the form of an AV stream containing video, audio, and a subtitle stream is old and well-known.

j. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to design a content rendering apparatus, as disclosed by Yamada/Yoshii/Candelore, to include the ability to render this well known data structure. One would have been motivated to do so because this would allow the device to play current DVD formats.

4. Regarding claim 17:

k. Yamada/Yoshii/Candelore/AOA discloses the limitations of claim 16, as described above. Yamada/Yoshii/Candelore/AOA, further, discloses *a playback authorization setting that indicates which playback of the video stream, the audio stream, and the subtitle stream is authorized or not* (see Yamada, column 10, lines 1-15: “coincident password”). Yamada does not specifically disclose *playlist information or the created predetermined package includes a playback authorization setting that is different from the playback authorization setting defined by the playlist information of the optical disc*. Yoshii, however, in Figure 4 discloses playlist information in the form of “Digital Frame-Specific Code” for the “Digital Image Data 11” (i.e., the optical disk). Additionally, Yoshii in Figure 4 discloses playlist information for the “secondary data” in the form of “Reproduction Start Point 32” and “Reproduction End Point 33” that provides the structure for combining the “Digital Image Data 11” with the “Secondary Data 12”. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to assign a unique playback authorization setting, as disclosed by Yamada, with the each of the playlist information disclosed by Yoshii. One would have been motivated to do so because this would limit additional “secondary data” to only those that are authorized.

5. Regarding claim 18:

l. Yamada/Yoshii/Candelore/AOA discloses the limitations of claim 17 as described above. Yamada, further, discloses further comprising *a transmitting unit that transmits an authorization request to a server apparatus, the authorization request indicating the*

combination of the content identifier read by the reading unit ("requested data contents") and the apparatus region code ("region code designating the place where the PC is installed"), wherein when the predetermined condition is satisfied, the server apparatus transmits an authorization response in reply to the authorization request ("when region codes coincide with each other, the control unit 93 confirms the IP address of the PC or EWS 95 on the client side contained in the packet of a communication protocol upon reception of a data supply request. After determining the authenticity of the region code, the control unit 93 permits data transfer"), and wherein, when the predetermined condition is not satisfied, the server apparatus transmits a non-authorization response (see at least column 22, lines 37-56 and FIG. 26 with associated text).

6. Regarding claim 19:

m. Yamada/Yoshii/Candelore/AOA discloses the limitations of claim 18 as described above. Yamada, further, discloses *the server apparatus includes a playback authorization list including combinations of a content identifier and a region code, each combination indicating that a content identified by a respective content identifier is allowed to be played back in a region identified by a respective region code; and the predetermined condition is satisfied when the playback authorization list of the server includes the combination of the content identifier and the apparatus region code indicated by the authorization request transmitted by the transmitting unit* (see at least column 22, lines 37-56 and FIG. 26 with associated text).

7. Regarding claim 20:

n. Yamada/Yoshii/Candalore/AOA discloses the limitations of claim 19 as described above. Yamada, further, discloses *the server apparatus includes a plurality of pieces of date/time information ("copyright use valid time data"), each piece of date/time information indicating, for a corresponding combination of a content identifier and a region code, a release date/time of a content identified by the content identifier for a region identified by the region code of the corresponding combination; the authorization request transmitted from the transmitting unit to the server apparatus includes a combination of (i) a current time in a region to which the playback apparatus belongs, (ii) the content identifier of the content to be played back, and (iii) the apparatus region code; and the predetermined condition is satisfied when the current time included in the authorization request is past the release date/time indicated in a piece of date/time information for a corresponding combination of the content identifier and the region code that is the same as the combination of the content identifier and the region code included in the authorization request* (see at least column 20, lines 63-67 and column 21, lines 1-22).

8. Regarding claim 21:

o. Yamada/Yoshii/Candalore/AOA discloses the limitations of claim 20 as described above. Yamada, further, discloses *the server apparatus includes a plurality of pieces of distributor information, each piece of distribution information indicating, for a corresponding combination of a content identifier and a region code, a distributor for a region identified by the region code of the corresponding combination; the authorization*

request transmitted from the transmitting unit to the server apparatus includes a combination of (i) the content identifier of the content to be played back, (ii) the apparatus region code, and (iii) the disc region code; and the predetermined condition is satisfied when a distributor indicated in a first piece of distributor information matches a distributor indicated in a second piece of distribution information, the first piece of distributor information indicating a distributor for a corresponding combination of the content identifier and the apparatus region code that is the same as the combination of the content identifier and the apparatus region code included in the authorization request, and the second piece of distributor information indicating a distributor for a corresponding combination of the content identifier and the disc region code that is the same as the combination of the content identifier and the disc region code included in the authorization request (see at least column 16, lines 14-67 and column 17, lines 1-34).

18. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

19. The Examiner interprets claim 15 to contain two conditional functions of the claimed "playback unit."

r. The following illustration is provided for clarity:

- i. let function A = “plays back the content”;
 - ii. let function B = “plays back a predetermined package created by replacing the predetermined part of the content recorded on the optical disc with the substitute content stored on the recording medium corresponding to the optical disc, based on the substitute play back order included in the recording medium corresponding to the optical disc”;
 - iii. let C_1 = “the disc region code matches the apparatus region code”;
 - iv. let C_2 = “a combination of the content identifier... and the apparatus region code satisfies a predetermined condition defined by an owner of the rights of the content.”; and
 - v. let $C_3 = (\sim C_1 \text{ and } C_2)$.
- s. According to claim 15, the playback unit performs “function A”, when C_1 is met. Also according to claim 15, the playback unit performs “function B”, when C_3 is met. Since C_1 is clearly not the negation of C_3 , then “function A” cannot be the alternative to “function B” and “function B” cannot be the alternative to “function A.” Furthermore, because “function A” and “function B” are not alternatives to each other, “function A” and “function B” must be conjunctive conditional functions carried out by the playback unit (i.e., the playback unit performs both “function A” and “function B” together). This is impossible, since “function A” is performed when C_1 is met and “function B” is performed when $C_3 = (\sim C_1 \text{ and } C_2)$ is met.
- t. Additionally, in this claim it is unclear what happens if C_1 and C_3 are not met (i.e., the claim is silent on what happens when C_1 and C_3 are not met, see §112 rejection

above). Moreover, it would be reasonable for one of ordinary skill in the art to assume that “function A” and “function B” are not performed by the playback unit when C₁ and C₃ are not met. In light of the claim being silent on what happens when C₁ and C₃ are not met, the Examiner will assume that the playback unit *implicitly* does nothing when C₁ and C₃ are not met. The function of the playback unit doing nothing is considered the alternative to performing “function A” and “function B.”

u. Accordingly, the prior art may disclose a playback unit performing the alternative to “function A” and the alternative to “function B”, namely a playback unit doing nothing, for anticipation purposes.

20. Applicants are reminded that “[a]s a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.” *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the Federal Circuit affirmed the Board’s claim construction of “further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased” as non-limiting since “this additional content did not narrow the scope of the claim because these limitations are stated in the permissive form ‘may.’”). See also *e.g.* MPEP §2106 II C.: which states, “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.” [emphasis in original].

21. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision.

22. Because the examined claims recite neither “step for” nor “means for”, the examined claims fail Prong (A) as set forth in MPEP §2181. Because all examined claims fail Prong (A) as set forth in MPEP §2181, the Examiner concludes that all examined claims do not invoke 35 U.S.C. §112, 6th Paragraph.

23. Using the broadest reasonable interpretation, the following definitions are relied upon by the Examiner when interpreting claim language:

v. **record** “To retain information, usually in a file.” (The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000).

w. **unit** “3a. A mechanical part or module.” *Id.*

x. **database** “A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining, and other functions.” (Computer Dictionary, 5th Edition, Microsoft Press, Redmond, WA, 2002);

y. **module** “1. In programming, a collection of routines and data structures that performs a particular task or implements a particular abstract data type. Modules usually consist of two parts: an interface, which lists the constants, data types, variables, and routines that can be accessed by other modules or routines; and an implementation, which is private (accessible only to the module) and which contains the source code that actually implements the routines in the module.” *Id.*

Response to Arguments

24. On page 9 of the Remarks Applicants argue:

Yamada fails to disclose or suggest a playback unit that, when the judging unit judges that the disc region code does not match the apparatus region code and when a combination of the content identifier read by the reading unit and the apparatus region code satisfies a predetermined condition defined by an owner of the rights of the content, plays back a predetermined package created by replacing the predetermined part of the content recorded on the optical disc with the substitute content stored on the recording medium corresponding to the optical disc, based on the substitute play back order included in the recording medium corresponding to the optical disc, as recited in independent claim 15 [emphasis in original].

z. This argument is moot in view of the new 35 U.S.C. §112, second paragraph rejection.

25. On page 11 of the Remarks Applicants argue:

Yoshii fails to disclose a recording medium that stores predetermined additional data corresponding to the optical disc, the predetermined additional data including a substitute playback order of the content recorded on the optical disc and a substitute content, and a predetermined part of the content recorded on the optical disc being replaced by the substitute content, the recording medium being distinct from the optical disc, as required by independent claim 15

aa. This argument is moot in view of the new 35 U.S.C. §112, second paragraph rejection.

26. In response to Applicants' arguments against the references individually (pp. 7-16), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

27. Applicants' remaining arguments with respect to claims 15-21 have been considered but are moot in view of the new grounds of rejection.

Conclusion

28. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
February 2, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621